

REMARKS

This Request for Reconsideration responds to the Non-Final Office Action dated August 5, 2011. Claims 31, 32, 35, 37, 39, 40, 47, 53, 62-64, 73, 74, and 79-81 have been withdrawn and Claims 1, 2, 10, 17, and 21 have been rejected over the prior art. Favorable reconsideration of this application in view of the following remarks is respectfully requested.

Rejections under 35 U.S.C. §103

a. The Official Action rejected Claims 1-2 and 21 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 4,619,278 to Smeed et al. ("Smeed") in view of U.S. Patent Application Publication No. 2003/0131859 to Li et al. ("Li").

The Official Action alleges:

Regarding claims 1 and 21, Smeed discloses a smoking article comprising: a tobacco rod having a wrapper formed around the tobacco rod, the wrapper including a patterned deposit on at least a portion of one surface of the wrapper (fig. 5 and column 1, lines 4-23); wherein the patterned deposit comprises additive [sic] such as a burn control agent and wherein the patterned deposit includes a concentration gradient of the catalyst between a first portion having a low concentration feature and a second portion having a high concentration feature, wherein the first portion and the second portion respectively are linearly distal portion and a linearly proximate portion of the wrapper with respect to an end of the wrapper and first loading (linearly distal portion) of the agent is less than the second loading (linearly proximal portion) (see claim 9). (Official Action at page 2).

Smeed does not expressly disclose the burn control agent. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to look for a burn control agent and the art and found that iron oxide is a typical burn control agent as taught by Li. Li teaches that it's well

known in the art to incorporate iron oxide as additives into tobacco articles (paragraph 6 of Li) and iron oxide can be used as a burn regulator (paragraph 7 of Li). Li also discloses iron oxide is capable of catalyzing, oxidizing and/or reducing the conversion of a constituent gas component in the mainstream and/or sidestream smoke of the smoking article (reducing the concentration of carbon monoxide) (paragraph 6 of Li). Therefore, it would have been obvious to one of ordinary skill in the art that the additive (iron oxide) as taught by Li is also capable of being a catalyst). (Official Action at page 3).

Claim 1 recites a smoking article comprising: a tobacco rod having a wrapper formed around the tobacco rod, the wrapper including a patterned deposit on at least a portion of one surface of the wrapper, wherein the patterned deposit comprises catalyst particles capable of catalyzing, oxidizing and/or reducing the conversion of a constituent gas component in the mainstream and/or sidestream smoke of the smoking article, wherein the patterned deposit includes a concentration gradient of the catalyst between a first portion having a low concentration feature and a second portion having a high concentration feature and wherein the first portion and the second portion respectively are a linearly distal portion and a linearly proximate portion of the wrapper with respect to an end of the wrapper.

Under MPEP §2143(G), Office personnel must resolve the Graham factual inquiries and then articulate the following:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

In this case, the Office Action has at least failed to demonstrate findings (1) and (2) listed above.

Smeed discloses a cigarette wrapper having an additive applied thereto. The additive can be a smoke producing agent, a smoke nucleation agent, a flavoring agent, and/or a physiologically active agent. (Col. 1, lines 10-15). The additive can be deposited on the wrapper in a predetermined pattern and the loading can decrease along the wrapper from the lit to the buccal end of the smoking article. (Col. 1, lines 24-45). The concentration can decrease longitudinally of the web in both directions away from a transverse center line. (Col. 8, lines 1-10). However, Smeed fails to disclose that the additive is iron oxide or that iron oxide could be applied as a patterned deposit to a wrapper to catalyze, oxidize and/or reduce the conversion of a constituent gas component in the mainstream and/or sidestream smoke of a smoking article as recited in Claim 1.

The Official Action admits that Smeed does not expressly disclose the burn control agent and turns to Li for the alleged disclosure that it is known to incorporate iron oxide as additives in tobacco articles. (Official Action at page 3). Li discloses methods of reducing constituents such as carbon monoxide in the mainstream smoke of a cigarette by incorporating catalysts in cut filler. Li further discloses that iron oxide can be incorporated into cigarettes to reduce or eliminate certain unwanted byproducts. (Paragraph [0006]). However, the Official Action has failed to identify any teaching, suggestion or motivation in Li to apply the catalyst to a wrapper or that applying a catalyst to the wrapper would be effective to catalyze, oxidize and/or reduce the conversion of a constituent gas component in the mainstream and/or sidestream smoke of a smoking article. Moreover, the Official Action has

failed to establish that there would be a reasonable expectation of success if the catalyst of Li were applied as a patterned deposit to the wrapper of Smeed. As such, Claim 1 is patentable over Smeed in view of Li.

Claims 2 and 21, which depend from Claim 1, are also patentable for at least the reasons Claim 1 is patentable.

b. The Official Action rejected Claim 10 under 35 U.S.C. §103(a) as allegedly unpatentable over Smeed in view of Li as applied above for Claim 1 and further in view of U.S. Patent No. 3,636,027 to Smith ("Smith").

Claim 10, which depends from Claim 1, is patentable for at least the reasons Claim 1 is patentable and because Smith fails to remedy the deficiencies of Smeed and Li.

c. The Official Action rejected Claim 17 under 35 U.S.C. §103(a) as allegedly unpatentable over Smeed as applied to Claim 1 above and further in view of U.S. Patent Application Publication No. 2003/0037792 to Snaird et al. ("Snaird").

Claim 17, which depends from Claim 1, is patentable for at least the reasons Claim 1 is patentable and because Snaird fails to remedy the deficiencies of Smeed and Li.

Conclusion

In view of the foregoing, it is submitted that all claims are in condition for allowance. Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be

helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that she be contacted at the number indicated below.


The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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